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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,693	10/27/2000	Jose Gabriel Menchero	VTEK-110	5993

27872 7590 08/26/2004

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EXAMINER

NGUYEN, NGA B

ART UNIT PAPER NUMBER

3628

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/698,693

Applicant(s)

MENCHERO, JOSE GABRIEL

Examiner

Nga B. Nguyen

Art Unit

3628



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,6,10-13 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6,12,13,18 and 19 is/are allowed.
- 6) ☒ Claim(s) 5,10,11,16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 3628

DETAILED ACTION

1. This Office Action is the answer to the Amendment filed on May 17, 2004, which paper has been placed of record in the file.

2. Claims 1-4, 7-9, 14, 15 have been canceled.

Claims 5, 6, 10-13, and 16-19 are pending in this application.

Terminal Disclaimer

3. The terminal disclaimer filed on May 17, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of July 11, 2000 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments/Amendment

4. Applicant's arguments with respect to claims 5, 6, 10-13, and 16-19 have been considered but are moot in view of new grounds of rejection.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 5, 10, 11, 16, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Maggioncalda et al (hereinafter Maggioncalda), U.S. Patent No. 5,918,217.

Regarding to claims 5, 10, 11, 16, and 17, Maggioncalda discloses a computer system, comprising:

a processor programmed to perform an arithmetic performance attribution computation to determine portfolio performance (figure 2, processor 202; column 6, lines 25-42);

a display device coupled to the processor arithmetic performance attribution computation for displaying a result of the arithmetic performance attribution computation (figure 1, display 221; column 6, lines 45-55).

Note that the claimed invention recites an intended use, although Maggioncalda fails to discuss the intended use, Maggioncalda's computer system is capable of performing an arithmetic performance attribution computation and displaying a result of the arithmetic performance attribution computation.

"The recitation of a new intended use for an old product does not make a claim to that old product patentable." *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997).

Allowable Subject Matter

7. Claims 6, 12, 13, 18, and 19 are allowed because the prior arts cited record do not disclose the claimed invention.

Conclusion

8. Claims 5, 10, 11, 16, and 17 are rejected.

Claims 6, 12, 13, 18, and 19 are allowed

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (703) 306-2901. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on (703) 308-0505.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 306-1113.

10. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
C/o Technology Center 3600
Washington, DC 20231

Or faxed to:

(703) 872-9326 (for formal communication intended for entry),

or

(703) 308-3691 (for informal or draft communication, please label

"PROPOSED" or "DRAFT").

Application/Control Number: 09/698,693

Page 5

Art Unit: 3628

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).

Nga B. Nguyen

A handwritten signature in cursive script that reads "Nga B. Nguyen".

August 20, 2004